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Reply dated 20 April 2006
Responsive to Office Action mailed on 16 March 2006

REMARKS

Claim Rejections Under 35 U.S.C. § 103 – Sasaki *et al.* in view of Putzer *et al.*

Claims 16-19 were rejected under 35 USC § 103(a) as being unpatentable over European Patent Application No. EP 0 951 890 to Uni-Charm Corporation (Sasaki *et al.*) in view of U.S. Patent No. 6,102,892 to Putzer *et al.*

Basis for rejections

Independent **Claim 16** contains the limitations that the chassis 100 includes a fastening element 110, 120 and that the fastening element is openable and refastenable. **Claims 17-19** depend from **Claim 16** and thereby contain these same limitations. It was explicitly admitted in the Office Action that Sasaki *et al.* fail to disclose the claimed “re-fastenable fastening element” (Office Action, page 3). It was then alleged in the Office Action that it would have been obvious to substitute the fasteners of Putzer *et al.* in place of the side bonds (spots 9) of Sasaki *et al.*

Traversal and averral that relevant requirements for *prima facie* obviousness have not been met

These rejections are hereby traversed on the ground that it was not shown in the Office Action that the requirements of MPEP 2142 or 2143 for the establishment of a *prima facie* case of obviousness have been met with respect to any of the rejected claims. According to MPEP § 2142:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.”

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the

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artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”

“The legal standard of “a preponderance of the evidence” requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not.”

“The decision on patentability must be made based upon consideration of all the evidence, including evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself.”

Lack of suggestion or motivation in the prior art

The entire disclosure of Sasaki *et al.* is directed to a “pants type disposable diaper” (title, Abstract, paragraphs 0001, 0007, 0013, 0014, 0022, Claims). The nature of a “pants type disposable diaper” is well-known in the relevant field of art. A pants type diaper is pre-closed such that the waist opening and the two leg openings are already formed at the point of manufacture, thereby enabling the user to apply the article onto the body of the wearer by simply pulling the article up over the wearer’s legs, without having to orient and arrange the side portions and fasten them together. See Figure 1 of Sasaki *et al.*, which is described in column 3 at lines 17-19 as showing “a partly cutaway pants type diaper constructed according to the present invention”. See also any of the numerous patents on training pants and pull-on diapers.

Consistent with this fact, Sasaki *et al.* explicitly describe that “spots 9 [are] intermittently arranged along” the “transversely opposite side edges”, where the “front and rear waist regions 6, 7” are “placed flat upon each other and joined together...to form a waist-opening 13 and a pair of leg-openings 14” (column 3, lines 38-45). Sasaki *et al.* also explicitly describe that “[t]o bond

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the respective members of the diaper 1 to each other, a suitable adhesive agent such as hot melt adhesive may be used. For the members which are of heat-sealable nature, the heat-sealing technique also may be utilized" (column 6, line 21-25). Clearly, the spots 9 are not openable and refastenable. Hence the admission in the Office Action that Sasaki *et al.* fail to disclose the claimed "re-fastenable fastening element".

No suggestion or motivation in the prior art for the proposed modification to the pants type diaper of Sasaki *et al.* was identified in the Office Action. Instead, only the conclusory statement that the modification would be made "to secure the article to the wearer" was provided. This statement reveals no relevant suggestion or motivation whatsoever because, by its very nature, the pants form of a disposable diaper does not require manipulatable fastening means in order "to secure the article to the wearer". Instead, a "pants type disposable diaper" is applied and secured to the wearer by simply being pulled up over the wearer's legs.

Yet, in direct contradiction to the clear focus of Sasaki *et al.* on the pre-closed pants form of a diaper, the aforementioned substitution of the fasteners of Putzer *et al.* in place of the side bonds (spots 9) of Sasaki *et al.* was alleged to be obvious, despite the fact that this substitution would have the effect of changing the pre-closed pants type disposable diaper of Sasaki *et al.* into an open diaper that must be fastened by the user when applying it onto the body of the wearer. It is important to note that this proposed modification would improperly change the principle of operation of the invention of Sasaki *et al.* by requiring the user to orient and fasten the side portions of the diaper together when applying it onto the body of the wearer. Thus, the proposed modification is directly contradictory to MPEP 2143.01 VI, which states that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."

In addition, the proposed modification would improperly render the invention of Sasaki *et al.* unsatisfactory for its intended purpose by denying the user the key benefit of the pants form of the diaper, which is to obviate the necessity of closing the sides and/or manipulating a fastening means while applying the diaper onto the body of the wearer. Thus, the proposed modification is

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directly contradictory to MPEP 2143.01 V, which states that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”

Given the lack of suggestion or motivation, the statement of rejection appears to be merely an allegation that a manipulatable fastening means like that of Putzer *et al.* could be substituted for the side bonds of Sasaki *et al.* However, as clearly stated in MPEP 2143.01 III, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Furthermore, as clearly stated in MPEP 2143.01 IV, the mere fact that the level of skill in the art may have been adequate to combine or modify the references is insufficient to establish a *prima facie* case of obviousness without some objective reason to combine their teachings.

Lack of line of reasoning in support of conclusion of obviousness

The cited references clearly do not expressly or impliedly suggest the claimed invention. Therefore, according to MPEP 2142, the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. This has clearly not been done because as explained above, the statement that the proposed modification would have been obvious in order “to secure the article to the wearer” reveals nothing relevant in light of the fact that by its very nature, the pants form of a disposable diaper does not require manipulatable fastening means in order “to secure the article to the wearer”. Instead, a “pants type disposable diaper” is applied and secured to the wearer by simply being pulled up over the wearer’s legs. In other words, the mere statement of the function of securing the article to the wearer does not constitute a line of reasoning as to why one skilled in the art would find the proposed substitution to be obvious.

Lack of showing that conclusion of obviousness is more probable than not

In the previous Reply, the explicit teachings of Sasaki *et al.* with respect to their product being a pants type disposable diaper with pre-closed sides and the attendant lack of any teaching or suggestion to substitute the fasteners of Putzer *et al.* were pointed out, explained, and specifically related to the claims. However, just as in the previous Office Action, no evidence in opposition

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was provided in the present Office Action. Clearly, the conclusion of obviousness cannot be shown to be more probable than not without any comparison of evidence.

Lack of showing of consideration of all the evidence

As explained above, in the previous Reply, the explicit teachings of Sasaki *et al.* and the lack of any support for the proposed modification were pointed out. However, in the present Office Action, the statements of rejection in the previous Office Action were merely repeated without any indication whatsoever that the previous Reply was considered. Clearly, the conclusion of obviousness cannot be shown to be based on the totality of the evidence without any consideration of the content of the previous Reply. It is not enough to merely repeat the rejections.

Additional Limitation of Claim 18

The additional limitation of Claim 18 that the fastening element includes a cohesive fastening element was not addressed in the Office Action. As explained in the previous Reply, the term "cohesive" is explicitly defined in the present specification and the cited references do not disclose any such fastening element. Thus, it has not been shown that the cited references, either alone or in combination, teach or suggest this additional limitation of Claim 18.

Additional Limitation of Claim 19

The additional limitation of Claim 19 that the mechanical fastener is adapted to engage a nonwoven was not addressed in the Office Action. As explained in the previous Reply, Putzer *et al.* disclose no such adaptation for engagement with a nonwoven. Thus, it has not been shown that the cited references, either alone or in combination, teach or suggest this additional limitation of Claim 19.

Summary with respect to rejections under 35 USC § 103(a)

The requirements of MPEP 2142 and 2143 for the establishment of a *prima facie* case of obviousness have not been met with respect to any of the rejected claims. Accordingly, it is respectfully requested that the rejections of Claims 16-19 under 35 USC § 103(a) be reconsidered and withdrawn.

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Allowable Subject Matter

The allowance of **Claims 1-15 and 20** is appreciated. It is respectfully averred that **Claims 16-19** are likewise allowable, as explained above.

Summary of this Reply

The rejections have been argued. No new matter has been added. The allowance of all twenty pending claims is respectfully requested.

Respectfully submitted,
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